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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/625,571	CHAE ET AL.
		Examiner	Art Unit
		RODNEY M. HENRY	4127

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 June 2004*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *24 July 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/16/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20071212

DETAILED ACTION

1.   The following is a non-final, first office action on the merits. Claims 1-20, as

originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claims 1–5, 7, 9, 10, 12 and 14-20 are rejected under 35 U.S.C. 102(e) as**

being anticipated by Shimakawa et al. (US 2003/0164979).

       As per claim 1, Shimakawa et al. discloses an advertisement system using,

using a printing apparatus (See Abstract, which discusses print services using a printer

for image information such as advertisements) comprising:

a layout setter providing layout information regarding document data and advertisement

data to be printed on a paper (See page 4 and FIG. 1, paragraph [0077], which

discusses form 1 (construed to be the layout setter) and its two layout areas; 1a and 1b

for printing document image and specific image (advertisements) respectively);

a document data processor that creates print data for a document by converting the

document data into a predetermined printing apparatus description language (It is

inherent that the printer is able to print since it received the data in a predetermined

language that it understands and that allows for accurate printing of the document)

based on the layout information provided by the layout setter, the document data

generated using a predetermined application program (See page 4, paragraph [0074],

which discusses image processor 3, which takes the inputs from the layout setter (form

1) and generates the document 4a and 4b according to FIG. 1);

an advertisement data processor creating print data for an advertisement by processing

a predetermined advertisement data according to the layout information provided from

the layout setter (See page 4, paragraph [0074], which discusses image processor 3,

and the specific image component 3b, which handles advertisements received form 1b

(layout information));

and a combining unit combining the print data for the document sent from the document

data processor and the print data for the advertisement sent from the advertisement

data processor to create combined print data including the advertisement (See page 4,

paragraph [0074], which discusses image processor 3, and component 3c, the Image

combination editing unit, and the combined printed product 4, as shown in FIG. 1).

   As per claim 2, Shimakawa et al. an advertisement server connected to the

advertisement data processor via a network and providing the predetermined

advertisement data to the advertisement data processor (See 4,5, paragraph [0079],

which discusses server 14 and component 14c, the registered data storing unit for

advertisements, the store image processor 3 (advertisement data processor), which are

connected via a network such as the internet as shown in FIG. 2).

As per claim 3, Shimakawa et al. discloses the layout setter sets one of
first through third layouts, the first layout in which the advertisement data is illustrated in
an advertisement area of the paper (See page 9, paragraph 0140], which discusses the
advertisement being placed in the blank space of FIG. 27), the second layout in which
the advertisement data is illustrated in a divided area of the paper (See page 9,
paragraph 0141], which discusses the advertisement being further divided into
advertisements parts 1 and 2 as shown in FIG. 28), and the third layout in which the
advertisement data is illustrated in the entire area of the paper (See page 5, paragraph
[0091], which discusses the various shapes that can be used for advertisement layouts.
Of the shapes shown in FIG. 6, it states that those patterns are examples only and not
limited to those shapes only, leaving room for full age advertisements).

As per claim 4, Shimakawa et al. discloses the layout setter sets one of
first through third layouts, the first layout in which the advertisement data is illustrated in
an advertisement area of the paper (See page 9, paragraph 0140], which discusses the
advertisement being placed in the blank space of FIG. 27), the second layout in which
the advertisement data is illustrated in a divided area of the paper (See page 9,
paragraph 0141], which discusses the advertisement being further divided into
advertisements parts 1 and 2 as shown in FIG. 28), and the third layout in which the
advertisement data is illustrated in the entire area of the paper (See page 5, paragraph
[0091], which discusses the various shapes that can be used for advertisement layouts.
Of the shapes shown in FIG. 6, it states that those patterns are examples only and not
limited to those shapes only, leaving room for full age advertisements).

As per claims 5, Shimakawa et al. discloses the document data processor scales down a size of the document data according to a predetermined ratio when the first or second layout is selected (See page 9, paragraph 0140], which discusses the reduction of a document image when an advertisement image is placed in the blank space that has the first and second advertisement insertion parts).

As per claim 7, Shimakawa et al. discloses the document data processor scales down a size of the document data according to a predetermined ratio when the first or second layout is selected (See page 9, paragraph 0140], which discusses the reduction of a document image when an advertisement image is placed in the blank space that has the first and second advertisement insertion parts).

As per claim 9, Shimakawa et al. discloses the advertisement server provides the advertisement data to the advertisement data processor, based on user information (See page 6, paragraph [0097], which discusses the user being able to register information along with advertisement image information as shown in FIG. 8).

As per claim 10, Shimakawa et al. discloses an advertisement method using, using a printing apparatus (See Abstract, which discusses print services using a printer for image information such as advertisements) comprising:

creating layout information regarding document data and advertisement data to be printed on a paper (See page 4, paragraph [0076], which discusses form 1 and its two layout areas; 1a and 1b for printing document image and specific image (advertisements) respectively);

converting the document data into print data for a document, based on the created

layout information and printed apparatus setting information, the document data

generated using a predetermined application program (See page 4, paragraph [0074],

which discusses image processor 3, which takes the inputs from the layout setter (form

1) and generates the document 4a and 4b according to FIG. 1) (It is further inhererent

that generation of the document using a processor, inherently implies use of a

predetermined application program to execute the necessary steps);

creating print data for an advertisement by processing a predetermined advertisement

data based on the layout information (See page 4, paragraph [0074], which discusses

image processor 3, and the specific image component 3b, which handles

advertisements received form 1b (layout information));

creating combined print data including the advertisement by combining the print data for

the document and the print data for the advertisement; and printing the combined print

data including the advertisement (See page 4, paragraph [0074], which discusses

image processor 3, and component 3c, the image combination editing unit, and the

combined printed product 4, as shown in FIG. 1).

      As per claim 12, Shimakawa et al. discloses the predetermined

advertisement data is provided from an advertisement server connected to a network

(See page 9, paragraph [0148], which discusses the server selecting advertisement

data to be outputted. Page 5, paragraph [0079] discusses the server being connected

via a network such as the internet).

As per claim 14, Shimakawa et al. discloses a machine readable storage

storing at least one program controlling a computer according to a process (See page 4,

paragraph [0074], which discusses computer recording medium such as CD-ROM and

the management of the information processing) comprising:

providing selectable layout information regarding document data and advertisement

data to be printed on paper (See page 8, paragraph [0134], which discusses a user

selecting a desired form pattern (layout)),

converting the document data into print data based upon the selected layout information

and printing the document data (See page 4, paragraph [0074], which discusses image

processor 3, which takes the inputs from the layout setter (form 1) and generates the

document 4a and 4b according to FIG. 1);

creating print data for a predetermined advertisement based upon the selected layout

information, creating combined print data including the advertisement by combining the

print data for the document data and the print data for the advertisement (See page 4,

paragraph [0074], which discusses image processor 3, and the specific image

component 3b, which handles advertisements received form 1b (layout information));

creating combined print data including the advertisement by combining the print data for

the document and the print data for the advertisement; and printing the combined print

data including the advertisement (See page 4, paragraph [0074], which discusses

image processor 3, and component 3c, the image combination editing unit, and the

combined printed product 4, as shown in FIG. 1).

As per claim 15, Shimakawa et al. discloses the selectable layout information comprises one of first through third layouts, the first layout in which the advertisement is printed in an advertisement area of the paper (See page 9, paragraph 0140], which discusses the advertisement being placed in the blank space of FIG. 27), the second layout in which the advertisement is printed in a divided area of the paper (See page 9, paragraph 0141], which discusses the advertisement being further divided into advertisements parts 1 and 2 as shown in FIG. 28), and the third layout in which the advertisement is printed in the entire area of the paper (See page 5, paragraph [0091], which discusses the various shapes that can be used for advertisement layouts. Of the shapes shown in FIG. 6, it states that those patterns are examples only and not limited to those shapes only. Examiner contends this incorporates full page advertisements).

As per claim 16, Shimakawa et al. discloses an advertising method, comprising: printing a combined print data of a document and an advertisement in response to a request to print the document (See page 8, paragraph [0123], which discusses the request for a form (combined document and advertisement data) by a user, and the process flow according to FIG. 33, which ends with the data being sent to the server. Page 4, paragraph [0079] discusses the server being connected to processor 3 and the print flow process associated with processor 3 is shown in FIG. 1).

As per claim 17, Shimakawa et al. discloses an advertising method, comprising:

providing office type printing services using a printing device (See Abstract, which discusses print services using a printer for image information such as advertisements);

generating a combined print data of a document and an advertisement in response to a

request to print the document by the printing device; and printing the combined data by

printing device (See page 8, paragraph [0123], which discusses the request for a form

(combined document and advertisement data) by a user, and the process flow

according to FIG. 33, which ends with the data being sent to the server. Page 4,

paragraph [0079] discusses the server being connected to processor 3 and the print

flow process associated with processor 3 is shown in FIG. 1).

   As per claim 18, Shimakawa et al. discloses providing selectable

print layouts and combining the document and advertisement print data according to the

print layout (See page 8, paragraph [0134], which discusses a user selecting a desired

form pattern (layout)).

   As per claim 19, Shimakawa et al. discloses the advertisements

are according to a user information (See page 6, paragraph [0097], which discusses

fields for information on the user and information on the advertisement as shown in FIG.

8).

   As per claim 20, Shimakawa et al. discloses a printer (See page 1, paragraph

[0013], which discusses a printer to output document image information comprising:

a programmed processor providing selectable layout information regarding document

data and advertisement data to be printed on paper (See page 4, paragraph [0074],

which discusses image processor 3, and the printing of document and advertisement

data according to FIG. 1);

converting the document data into print data based upon the selected layout information

upon printing the document data (See page 4, paragraph [0074], which discusses

image processor 3, which takes the inputs from the layout setter (form 1) and generates

the document 4a and 4b according to FIG. 1);

creating print data for a predetermined advertisement based upon the selected layout

information,

(See page 4, paragraph [0074], which discusses image processor 3, and the specific

image component 3b, which handles advertisements received form 1b (layout

information));

creating combined print data including the advertisement by combining the print data for

the document data and the print data for the advertisement, and printing the combined

print data including the advertisement (See page 4, paragraph [0074], which discusses

image processor 3, and component 3c, the image combination editing unit, and the

combined printed product 4, as shown in FIG. 1).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimakawa et al. (US 2003/0164979), in view of Matsumoto et al. (US 6,747,125).**

As per claim 6, Shimakawa et al. discloses the elements of the claimed invention, but fails to explicitly disclose the advertisement data processor performs watermark processing for the advertisement data when the third layout is selected.

Matsumoto et al. teaches an image processing apparatus, method and recording medium having the advertisement data processor perform watermark processing for advertisement data (See claim 4, which discusses embedding watermark-information in another part of the tiles of the third image data (third layout)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shimakawa et al. to use watermarks on images as taught by Matsumoto et al. in order to provide a good measure of security and authentication within the printed documents.

As per claim 8, Shimakawa et al. discloses the elements of the claimed invention, but fails to explicitly disclose the advertisement data processor performs watermark processing for the advertisement data when the third layout is selected.

Matsumoto et al. teaches an image processing apparatus, method and recording medium having the advertisement data processor perform watermark processing for the advertisement data when the third layout is selected (See claim 4, which discusses embedding watermark-information in another part of the tiles of the third image data (third layout)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shimakawa et al. to include the advertisement data processor performing watermark processing for the advertisement data when the third layout is selected as taught by Matsumoto et al. in order to provide a good measure of security and authentication within the printed documents.

6.   **Claims 11, and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimakawa et al. (US 2003/0164979), in view of Mori et al. (US 7,046,385).**

As per claim 11, Shimakawa et al. discloses the elements of the claimed invention, but fails to explicitly disclose the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data, and an intensity information of watermark processing.

Mori et al. teaches a print control method, apparatus, computer-readable storage medium, and program embodied in a computer-readable medium for managing document information on a page basis having the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data, and an intensity information of watermark processing (See column 11, lines 31-44, which discusses "layout designation", and reducing each side of one print page by 70%. Column 11, lines 45-47 discusses watermark attributes).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shimakawa et al. to include the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data, and an intensity information of watermark processing as taught

by Mori et al. in order to provide a good measure of security and authentication within
the printed documents as well as layout control in terms of document sizing.

As per claim 13, Shimakawa et al. discloses a computer readable recording
medium storing programs executable by a computer, wherein the programs comprise:
a first program creating layout information containing layouts of document data and
advertisement data to be printed on a paper (See page 4 and FIG. 1, paragraph [0077],
which discusses form 1 (construed to be the layout setter) and its two layout areas; 1a
and 1b for printing document image and specific image (advertisements) respectively. It
is inherent a program is used to perform this function);
a second program converting the document data into print data for a document based
on the layout information and printer setting information, the document data generated
using a predetermined application program (See page 4, paragraph [0074], which
discusses image processor 3, which takes the inputs from the layout setter (form 1) and
generates the document 4a and 4b according to FIG. 1. It is inherent that a
predetermined application program is used to perform this function);
a third program creating print data for an advertisement by processing a predetermined
advertisement data based on the layout information (See page 4, paragraph [0074],
which discusses image processor 3, and the specific image component 3b, which
handles advertisements received form 1b (layout information). It is inherent that a
program is used to perform this function); and
a fourth program creating combined print data including the advertisement by combining
the print data for the document and the print data for the advertisement (See page 4,

paragraph [0074], which discusses image processor 3, and component 3c, the Image combination editing unit, and the combined printed product 4, as shown in FIG. 1. It is inherent a program is used to perform this function).

However Shimakawa et al fails to explicitly disclose a scale-down ratio of a display size of the document data, and watermarking intensity information.

Mori et al. teaches a print control method, apparatus, computer-readable storage medium, and program embodied in a computer-readable medium for managing document information on a page basis having the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data, and an intensity information of watermark processing (See column 11, lines 31-44, which discusses "layout designation", and reducing each side of one print page by 70%. Column 11, lines 45-47 discusses watermark attributes. It is inherent a program is used to perform this function).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shimakawa et al. to include the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data, and an intensity information of watermark processing as taught by Mori et al. in order to provide a good measure of security and authentication within the printed documents as well as layout control in terms of document sizing.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

Smith, Mark S. et al. (US 5995942) discloses a store-level marketing system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3627

January 4, 2008

rmh